

Appl. No. 09/548,728
Amendment and/or Response
Reply to Office action of 12 November 2003

Page 8 of 10

REMARKS / DISCUSSION OF ISSUES

Claims 1-14 are pending in the application.

The Examiner is respectfully requested to state whether the drawings are acceptable.

The Examiner has objected to the specification for containing a repeated phrase. The Applicant thanks the Examiner for this attention to detail. The specification is suitably amended herein.

The Examiner has rejected:

claims 1 and 6 under 35 U.S.C. 103(a) over Wang (USP 5,251,315) and Benson (USP 5,935,246);

claims 2, 4, 5, 7, 9, and 10 under 35 U.S.C 103(a) over Wang, Benson, and Davis (USP 5,568,552);

claims 3 and 8 under 35 U.S.C. 103(a) over Wang, Benson, and Bereiter (USP 5,754,763); and

claims 11-14 under 35 U.S.C. 103(a) over Wang and Davis.

The Applicant respectfully traverses these rejections.

The Applicant teaches a secure check-in check-out method and devices wherin the check-in check-out device provides content material to a receiving device, and registers a "return" of the content material from the receiving device – a "return" corresponding to the deletion of the material from the receiving device. To effect the security of this system and method, the check-in check-out device issues a security challenge to the receiving device when the material is provided to the receiving device, and receives the response to this challenge when the receiving device returns the material to the check-in check-out device. If the response does not correspond to the challenge, the return is not registered in the check-in check-out device. In this manner, only the receiving device that received the material and the challenge can return the material.

In each of the Applicant's independent claims 1, 6, and 11, the Applicant includes receiving a security response from the receiving device when the receiving device effects a return of content material to the check-in check-out device, to verify that the security response

Appl. No. 09/548,728
Amendment and/or Response
Reply to Office action of 12 November 2003

Page 9 of 10

corresponds to the security challenge that was issued when the check-in check-out device provided the content material to the receiving device.

Wang teaches a document check-in check-out system wherein changes to a source document are not permitted if a copy of the source document has been checked-out for editing. When the edited document is returned to the system, the source document is updated to reflect the changes, either by replacing the source document or by creating a new version of the source document. A "CHECKIN-PARAMETER-SET" is compared with a "CHECKOUT-PARAMETER SET" that was created when the copy was made, to determine whether to update the source document. Wang teaches that the CHECKIN-PARAMETER-SET should include an identification of the source library, and that the check-in requester must correspond to the check-out requester and must still retain edit authorization. (Wang column 7, line 10 through column 8, line 14.) Wang is silent with regard to security safeguards for this system.

Wang does not teach or suggest providing a security procedure to verify that the same *device* that received the source document is the *device* that returns the source document. In a typical document check-in check-out system, a user who checks out a document is free to place the document on whatever device is convenient to the user. For example, a user may check-out the source document to his/her desktop computer, then transfer it to his/her laptop, and then return it to the source library from the laptop. The same user must return the material, but the same user need not return the material from the same *device* at which the material was first received. Absent any teaching of Wang to the contrary, it cannot be said that Wang verifies that the same device is used to check-in and check-out the material.

Because Wang does not teach a check-in check-out system that verifies that the same *device* that received the material is the *device* that returns the material, the Applicant respectfully maintains that claims 1-14 are patentable over Wang and any combination of Benson, Davis, and/or Bereiter. However, in the interest of advancing prosecution of this case, the following additional comments are provided.

The Applicant acknowledges that challenge-response protocols are common in the art. However, conventional protocols, such as taught by Benson and Davis, effect the challenge-response procedure *prior* to providing a copy of the content material. In the Applicant's invention, the challenge is provided concurrently with the copy of the content material,

Appl. No. 09/548,728
Amendment and/or Response
Reply to Office action of 12 November 2003

Page 10 of 10

without regard to a response to the challenge. Prior art challenge-response protocols do not allow for providing copies of the protected material before the response is received, as specifically claimed by the Applicant. Further, most challenge-response protocols include a time-out function that does not accept a response after a given time limit, so as not to allow time to "break" the security code. In the Applicant's claimed invention, the response to the challenge is provided when the content material is removed from the receiving device. In a typical environment, the removal of the content material from the receiving device may occur days, weeks, or months after the material is provided to the receiving device.

In view of the foregoing, the Applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Robert M. McDermott, Attorney
Registration Number 41,508
patents@lawyer.com

1824 Federal Farm Road
Montross, VA 22520
Phone: 804-493-0707
Fax: 215-243-7525